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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/070,611	07/22/2002	Martin Von Bergen	029976-0101	9060

22428 7590 04/09/2004

FOLEY AND LARDNER  
SUITE 500  
3000 K STREET NW  
WASHINGTON, DC 20007

EXAMINER

CHEU, CHANGHWA J

ART UNIT	PAPER NUMBER
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1641

DATE MAILED: 04/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/070,611

Applicant(s)

BERGEN ET AL.

Examiner

Jacob Cheu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 1/22/2004.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 28-54 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 28-54 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

Applicant's preliminary amendments filed on 1/22/2004 have been received and entered into record. Claims 1-27 have been cancelled and claims 28-54 have been added.

#### ***Election/Restrictions***

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 28-29, 33-41, 47-54, drawn to a method of identifying and obtaining an inhibitor capable of modifying the paired helical filaments (PHF) formation, wherein a peptide selected from SEQ ID No. 6, 7, 8, or 9 is present for screening, with a special technical feature of detecting the presence, decrease, or absence of nucleation sites for PHF assembly, and/or the presence, decrease or absence of aggregation products, wherein said absence and/or decrease of is indicative of putative inhibitors of PHF formation.

Group II, claim(s) 30-32, drawn to a method of identifying and obtaining an inhibitor of PHF formation, wherein a peptide selected from SEQ ID No. 6, 7, 8, or 9 is present for screening, with a special technical feature of measuring whether compounds displace the molecule from the complex.

Group III, claim(s) 42-46, drawn to a method for detecting the PHF formation, with a special technical feature of detecting the presence, absence, decrease or increase of PHFs and/or nucleation sites of PHF assembly.

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2. The inventions listed as Groups I-III do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

Wischik et al. (WO 9630766) teach a method a method of screening for an agent that modulates or inhibits tau-tau association comprising contacting: (a) a cell line transfected with the tau protein or a deriv. contg. the tau core fragment or a vector capable of expressing a tau protein or a deriv. contg. the tau core fragment with an agent suspected of being capable of modulating or inhibiting tau-tau association; and (b) detection of the cell line viability and/or the cell line morphology; (2) cpds. which modulate or inhibit tau-tau association as obtainable by the above methods. (See Abstract, and claims 1, 2, 3, 12) Particularly, the SEQ ID No. 7 recited in current invention is taught by Wischik et al.. (See attached Sequence Search Report) Therefore, the invention of Group I does not fulfill the requirement of unity under Rule 13.1 PCT. Accordingly, the different special technical features of each Group I-III, are not shared by each invention Group. Thus, Group I-III do not relate to a single general inventive concept.

3. Furthermore, SEQ ID No. 6-9 do not share a common core structure, thus are deemed to be patentable distinct species. Applicant needs to elect one species for examination if Group I or II is elected for examination.

4. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jacob Cheu whose telephone number is 571-282-0814. The examiner can normally be reached on 9:00-5:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Long Le can be reached on 571-272-0823. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jacob Cheu

Examiner

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April 1, 2004



LONG V. LE  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600

04/05/04